

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed: July 10, 2006

Hearing: December 20, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Commerce Bancorp, Inc.

Serial No. 76127975

Timothy D. Pecsenty and David M. Perry of Blank Rome LLP,
for Commerce Bancorp, Inc.

David Yontef, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Walters, Rogers and Zervas, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

Commerce Bancorp, Inc. has appealed from the final
refusal of the examining attorney to register the following
mark on the Principal Register for "banking services" in
Class 36:¹

¹ Application Serial No. 76127975 was filed on September 14,
2000, and asserts a date of first use and first use in commerce
of June 29, 1973. Applicant has disclaimed the word BANK.



The examining attorney refused to register applicant's mark in view of his requirement that applicant disclaim the term COMMERCE. According to the examining attorney, the term is merely descriptive of applicant's services. 15 U.S.C. § 1056(a). See also 15 U.S.C. § 1052(e)(1).

Applicant filed an appeal brief and a reply to the Examining Attorney's brief. An oral hearing was held before the Board on December 20, 2005.

We first address one preliminary matter before turning to the merits of this appeal. Applicant's appeal brief does not conform to the requirements of Trademark Rule 2.142(b)(2), 37 C.F.R. § 2.142(b)(2), in that it is twenty-six pages long, and the rule specifically states that, without prior leave of the Board, an appeal brief may not exceed twenty-five pages. TBMP § 1203.01 (2d ed. rev. 2004) states that "[i]f an applicant files a brief that exceeds the twenty-five page limit without prior leave of the Board, the brief will not be considered, although the failure to file a conforming brief will not be treated as a failure to file a brief which would result in the dismissal

of the appeal." In view of the rule and this stated policy, we give applicant's appeal brief no consideration.²

The examining attorney argues as follows at p. 2 of his brief:

The term COMMERCE in the proposed mark merely describes the character, feature and/or function of the applicant's banking services; namely, (1) a commercial bank whose principal functions are to receive demand deposits and to make short-term loans and/or (2) a bank operating in interstate commerce. As such, when consumers encounter the words COMMERCE and BANK used with banking services they will immediately, without the need for conjecture, perceive the nature of the services.

The term "commerce" means "the buying and selling of goods, especially on a large scale, as between cities or nations. See synonyms at business." The examining attorney respectfully requests that the Board take judicial notice of the fact that when the term "commerce" is used as a synonym for business the term means "the exchange and distribution of goods or commodities: laws regulating interstate commerce," as established by the attached definition from *The American Heritage® Dictionary of the English Language*, 4th Ed. Houghton Mifflin Co. (2000), which is attached as Exhibit A. A printout of a similar definition from *Merriam-Webster's Collegiate Dictionary* is also attached for the Board's review. TBMP Section 704.12.

The Board is further urged to take judicial notice of the definition of "commercial bank" as meaning "a bank whose principal functions are to receive demand deposits and to make short-term loans" and "commercial" as meaning "occupied with

² Applicant's attorney was advised during the oral hearing that the Board would not consider applicant's appeal brief.

Applicant's request filed after the hearing on December 27, 2005 that the Board consider the brief, or delete certain portions of the brief, is denied.

or engaged in commerce or work intended for commerce; of or relating to commerce," as noted by the attached definitions from *The American Heritage® Dictionary of the English Language*, 4th Ed., Houghton Mifflin Co. (2000) and *Merriam-Webster Online Dictionary*, Merriam-Webster, Inc. (2005) ... Printouts of similar definitions from Merriam-Webster's Collegiate Dictionary are also attached for the Board's review.

The examining attorney also relies on excerpts from news articles taken from the Nexis database and third party registrations which, according to him, "show common descriptive usage of the terms COMMERCE BANK by several banks," mentioning Valley Commerce Bank of Phoenix, Detroit Commerce Bank, First Commerce Bank, Texas Commerce Bank and others. More specifically, the examining attorney notes that Registration No. 2611416 for FIRST COMMERCE BANK includes a disclaimer of COMMERCE BANK and Registration No. 1868580 for TEXAS COMMERCE BANK is registered under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), and includes a disclaimer of BANK.

In its reply brief, applicant argues that "the purpose, function, characteristic or feature upon which the disclaimer is based must indeed be immediately recognized as a key, primary, intended, or significant one, and that in the instant case, the Examining Attorney fails to appreciate the immediacy and significance requirements ...," citing *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed.

Cir. 1987); *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBASSOCIATES*, 180 USPQ 338 (TTAB 1973), Reply at p. 3. Applicant notes that "[c]onnections to distal or secondary features, purposes, characteristics, or attributes are not sufficient to ground a determination of descriptiveness"; and that the examining attorney has "improperly, or at best, overzealously, misstated or diluted the applicable law in order to support the misplaced disclaimer requirement." Reply at pp. 5 and 7.

Applicant also maintains that the examining attorney relies not only on the definition of "commerce" to arrive at his conclusion that the term is descriptive, but also relies on the terms "business," "commercial" and "commercial bank," none of which is part of applicant's mark; that the ordinary consumer would not "think" about "large scale buying and selling of goods" - which is part of the cited definition of "commerce" - when perceiving the term "commerce" in applicant's mark; and that the examining attorney's definition of commerce is "pertinent in the fields of international trade or import/export businesses, [but] is in no way primary, key, significant, or central, when properly viewed in the context of a retail bank"

Further, applicant contests the propriety of the examining attorney's reliance on (a) a definition of

"business" merely because the dictionary definition of "commerce" referenced above says, in part, "[s]ee *synonyms at business*"; and (b) the explanation within the dictionary entry for "business" that when the synonym "commerce" is used, it is used to refer to "the exchange and distribution of goods or commodities: laws regulating interstate commerce." According to applicant, neither the definition nor the explanation has a connection to banking services.

Applicant also challenges the examining attorney's reliance on the definitions of "commercial bank" and "commercial." Applicant observes that its mark does not include these terms; and that unlike the use of "commercial bank" in a bank's name, which indicates that the bank receives deposits and makes loans, the use of "commerce" in a bank's name does not, without "additional leaps and thoughts," indicate that the bank makes loans.

Applicant concludes as follows:

Where "COMMERCE" says nothing immediately of the ordinary and most significant facets of banking services - e.g., savings account services, checking account services, money market account services, ATM services, certificate of deposit services, and the like - it is suggestive under the Trademark Act. The conclusion of descriptiveness drawn by the Examining Attorney is transitive and indirect in nature, and totally lacking in the immediacy and significance required for a descriptiveness determination under trademark law. See In re Hutchinson Tech. Inc., 852 F.2d 552 (Fed. Cir. 1988)"

In the final analysis, the leaps from "commerce" to "business," then to synonyms for "business," over to "commercial bank" and back to "commercial," are the very embodiments of the imagination, thought, and perception that are the touchstones of a suggestive - not merely descriptive - term." Brief at pp. 11- 12.

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Gyulay*, 3 USPQ2d at 1009; and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Courts have long held that to be "merely descriptive," a term need only describe a single significant quality or property of the goods or services. *In re Gyulay*, 3 USPQ2d at 1009; *Meehanite Metal Corp. v. International Nickel Co.*, 262 F.2d 806, 120 USPQ 293 (CCPA 1959). It is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316 - 1317 (TTAB 2002). See also *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990). As the Board has explained:

... the question of whether a mark is merely descriptive must be determined not in the abstract, that is, not by asking whether one can guess, from the mark itself, considered in a vacuum, what the goods or services are, but rather in relation to the goods or services for which registration is sought, that is, by asking whether, when the mark is seen on the goods or services, it immediately conveys information about their nature.

In re Patent & Trademark Services Inc., 49 USPQ2d 1537 (TTAB 1998).

We agree with applicant that the examining attorney has not established herein that the term COMMERCE as used in applicant's mark is merely descriptive of applicant's banking services. The definition of "commerce" cited by the examining attorney in initially requiring a disclaimer of "commerce," i.e., "the buying and selling of goods, especially on a large scale, as between cities or nations," does not suggest anything about an ingredient, quality, characteristic, feature, function, purpose or use of the services that a bank provides, defined as "an establishment for the custody, loan, exchange, or issue of money, for the extension of credit, and for facilitating the transmission of funds." See definition of "bank" and "banking," from *Merriam Webster's Collegiate Dictionary* (10th ed.), submitted with the examining attorney's brief, of which we

take judicial notice.³ Such services include those services that applicant stated it provides, i.e., "savings account services, checking account services, money market account services, ATM services, certificate of deposit services" Reply at p. 11.

Additionally, we are not persuaded by the examining attorney's contention that "commerce" is a merely descriptive term because the dictionary entry for "commerce" includes the term "business" as a synonym for "commerce." See brief at p. 2. Even if we assume that the consuming public would understand "commerce" as "business," the term "business" is a broad one and can include any number of activities.⁴ Hence, this evidence does not establish that "commerce" is merely descriptive of any particular characteristic, feature and/or function of applicant's services. In this regard, our consideration of "commerce" in connection with applicant's banking services is not dissimilar to the Federal Circuit's treatment of

³ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁴ The explanatory phrase within the definition of "business" that refers to "commerce," i.e., "[c]ommerce and trade refer to the exchange and distribution of goods or commodities: laws regulating interstate commerce," which the examining attorney cites, is simply too ambiguous to suggest anything regarding a specific characteristic, feature or function of banking services.

"technologies" in connection with "etched metal electronic components; flexible circuits; actuator bands for disk drives; print bands; increment discs; [and] flexible assemblies for disk drives" in the mark HUTCHINSON TECHNOLOGIES. See *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988). In concluding that "technologies" was not a merely descriptive term, the court stated, "'technology' is a very broad term which includes many categories of goods. The term 'technology' does not convey an immediate idea of the 'ingredients, qualities, or characteristics of the goods' listed in Hutchinson's application." *Id.*, 7 USPQ2d at 1492.

The examining attorney has also argued that COMMERCE is merely descriptive of "(1) a commercial bank whose principal functions are to receive demand deposits and to make short-term loans" Brief at p. 2. "Commercial" is defined as "of or relating to commerce" - there clearly is a relationship between the terms "commerce" and "commercial." However, "commercial" in the context of banking is a term with specific significance in that it is part of the defined phrase - "commercial bank." See definition of "commercial bank," i.e., "a bank whose principal functions are to receive demand deposits and to make short-term loans," submitted by the examining attorney

with his brief, of which we take judicial notice. Because "commercial" has significance in the banking context, the consuming public would not likely make an immediate association between "commerce" and banking services, even if "commercial" is a form of the word "commerce." An additional mental step is required to make the connection between "commerce" and "commercial." Hence, the examining attorney has not established that "commerce" merely describes a significant characteristic, feature or function of applicant's banking services and therefore has not established that the term is merely descriptive of such services. See *In re MBAssociates*, 180 USPQ at 339.

The remaining evidence submitted by the examining attorney also does not establish that "commerce," as it appears in this mark, is merely descriptive of applicant's services. The examining attorney has entered articles from the Nexis database into the record, with his July 3, 2003 and March 25, 2004 Office actions, that include "Commerce Bank." See, e.g., "Plains Commerce Bank" from *Aberdeen American News* (South Dakota), March 6, 2004; "Pacific Commerce Bank" from *Los Angeles Times*, November 11, 2002; and "Seacoast Commerce Bank" from *ABA Banking Journal*, March 2004. Additionally, with his April 12, 2005 Office action, the examining attorney has submitted printouts of

web pages from banks having "commerce" in their names. See, e.g., "Commerce Bank & Trust" from www.bankatcommerce.com; "The Commerce Bank of Washington" from www.tcbwa.com; "Ann Arbor Commerce Bank" from www.annarborcommerce.com; and "Virginia Commerce Bank" from www.vcbonline.com. Each use of "Commerce Bank" in the examining attorney's evidence is as a part of the name of a bank. Such uses do not establish use of "commerce" in a descriptive manner but rather simply demonstrate that the term "commerce" is widely used in marks for banks. Cf. *In re Hutchinson Technologies*, 7 USPQ2d at 1492 ("... the fact that the term 'technology' is used in connection with computer products does not mean that the term is descriptive of them. ... At most, all that may be concluded from Hutchinson's concession is that a mark including the term 'technology,' which mark is used on computer products, is a weak mark for those goods.").

The examining attorney has also pointed out that Registration No. 1868580⁵ for the mark TEXAS COMMERCE BANK including "banking services" has been registered under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), and that Registration No. 2611416 for the mark FIRST COMMERCE BANK

⁵ Renewed September 1, 2005.

for "banking services" includes a disclaimer of "commerce bank." Both registrations were made of record with the July 3, 2003 Office action. In turn, applicant, at pp. 13 - 14 of its reply brief, points to the following two registrations which did not register under Section 2(f) and which do not include a disclaimer of "commerce":

Registration No. 2831145 for COMMERCE CHECKVIEW for "providing customers with bank statements containing images of their checks rather than the actual checks"; and

Registration No. 2839401 for COMMERCE TREASURYDIRECT for "banking services provided to business customers ..."

Of course, we are not privy to the records of any of these registrations and are not bound by the prior determinations made by the Office. Each case must be decided on its own set of facts. While uniform treatment under the Trademark Act is highly desirable, our task here is to determine, based on the record before us, whether applicant's mark is registrable. See *Jean Patou, Inc. v. Aristocrat Products Corp.*, 202 USPQ 130 (TTAB 1979); and 5 J. McCarthy, *McCarthy on Trademarks & Unfair Competition* §32:103 (4th ed. database updated 2006). Even if we were to assume identical records in these registrations, what this evidence demonstrates at most is that there may be

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conflicting practices with respect to this term within the Office.

We have also considered the remaining arguments set forth by the examining attorney and do not find them persuasive of the issue involved in this appeal.

Decision: The requirement for a disclaimer of "COMMERCE" is reversed. Applicant's current disclaimer of "BANK" shall remain of record.